

REMARKS

The Office Action mailed September 7, 2004 has been received and carefully considered.

Claims 1-12, 16-36 and 59-95 are pending in the application, of which claims 16-36, 60-70, 86-88 and 91-95 are withdrawn. Claims 1-12, 59, 71-85 and 89-90 stand rejected. Claims 1-2, 7, 10, 59, 71, 78, 81, 85 and 89-90 stand rejected under 35 U.S.C. § 112, second paragraph as assertedly indefinite for failing to particularly point out and distinctly claim the invention. Claims 1-8, 10-12, 59, 71-79, 81-85 and 89-90 stand rejected under 35 U.S.C. § 103(a) as assertedly obvious over “Profile, Indiana Journal of Optometry,” Vol. 2, No. 1, pages 5-10 by Thibos et al. (Thibos). Claims 1-3, 7 and 11 also stand rejected as assertedly obvious over WO 92/01417 by Horwitz (Horwitz). Applicants respectfully traverse the rejections and request reconsideration in view of the following remarks.

I. Amendments to the Claims

Claims 1, 2, 10, 71, and 89 have been amended. New claims 96-98 have been added. Support for the amendments and new claims is found at least at paragraph 40 and throughout the specification as originally filed. No new matter is presented.

II. Restriction Requirement

Applicants acknowledge that the Restriction Requirement has been made final and that only those claims elected by Applicants and designated as Group Ia have been examined. Those claims directed to the non-elected invention have been cancelled without prejudice and Applicants reserve the right to file one or more divisional applications directed to the subject matter thereof.

III. Information Disclosure Statement

Applicants thank the Examiner for correcting the IDS to properly reflect publication number JP-11352445 which was inadvertently listed by its application number. The Examiner has further stated that the large number of references already provided are cumulative. *See* Office Action at page 2. Applicants appreciate the Examiner's statement that the references are largely cumulative. While Applicants agree that the cited references are voluminous and in some respects may be cumulative, Applicants also respectfully submit that they are aware of a large number of references. Applicants have presented the references cited in the Information Disclosure Statements to the Patent Office in Applicants' attempt to ensure they have met their duty of disclosure under 37 C.F.R. § 1.56.

IV. Rejection under 35 U.S.C. § 112, 2nd paragraph

Claims 1-2, 7, 10, 59, 71, 78, 81, 85, 89 and 90 stand rejected under 35 U.S.C. § 112, second paragraph as assertedly indefinite for failing to particularly point out and distinctly claim the invention. Specifically, the Examiner has stated that the terms "non-conventional" and "conventional" refractive error, as well as the render the claims vague and indefinite. The Examiner has further stated that in claims 71 and 89, the phrase "highest level of vision correction" is vague absent a reference to what the highest level of vision correction is relative.

Applicants respectfully submit that the claims prior to the amendments herein were definite because those of ordinary skill in the art would have readily appreciated the metes and bounds of the claimed invention. Nevertheless, in the interest of expediting prosecution, Applicants have amended the claims and submit that the claims as amended address the Examiner's concerns and continue to be definite.

V. Rejection under 35 U.S.C. § 103(a) to Thibos

Claims 1-8, 10-12, 59, 71-79, 81-85 and 89-90 stand rejected under 35 U.S.C. § 103(a) as assertedly obvious over “Profile, Indiana Journal of Optometry,” Vol. 2, No. 1, pages 5-10 by Thibos et al. (Thibos). Applicants respectfully traverse the rejection.

Thibos is directed to an electronic spectacle with a programmable optical element with characteristics that can be dynamically altered as required by a patient. Thibos describes that the spectacle contains an array of cells that can be individually addressed to correct for traditional parameters (i.e., conventional refractive error) and higher order, irregular aberrations (i.e., non-conventional refractive error). *See* Thibos, pg. 6, first column - pg. 7, second column.

The Examiner states that the only difference between the lens described in Thibos and that of Applicants’ claimed invention is that Thibos does not specifically state that the lens has a peripheral edge that can be modified. However, the Examiner takes Judicial Notice that the edges of eyeglass lenses may be modified prior to fit within a particular eyeglass frame. *See* Office Action at page 5.

Applicants respectfully submit that Thibos does not teach a lens that has a peripheral edge capable of being modified. Thibos teaches that the liquid-crystal lens built and analyzed by Thibos is shown in the cover illustration. *See* Thibos at pg. 8, first column. Quite simply, the lens shown on the cover has an edge which could not be modified. Any modification would clearly cut into the outer liquid crystal cells, rendering it partially or wholly inoperative.

The Examiner relies on Thibos’ teaching that the lens could be a “hybrid” lens including ordinary glass for the possibility that the lens could be modified. However, Thibos still does not teach, disclose, or suggest how the referenced “hybrid” lens could be modified at its edge. In fact, the “hybrid” lens discussed in Thibos is described as a doublet, where the ordinary glass is

used to correct spherocylindrical refractive error. *See* Thibos at pg. 8, second column.

Applicants respectfully submit that while those of ordinary skill in the art would appreciate a doublet as a compound lens made from two lens elements, they would not necessarily appreciate that either lens element would be larger or smaller than the other element such that the edge of the hybrid lens could be modified in such a manner to affect only one of the lens elements. This is particularly true in the absence of any teaching by Thibos of how making such a doublet would be accomplished, much less whether or how it had a peripheral edge that could be modified.

For at least these reasons, Applicants respectfully submit that Thibos fails to teach, disclose or suggest Applicants' claimed invention and that the Judicial Notice taken by the Examiner fails to take overcome its deficiencies. Therefore, the rejection should be withdrawn.

VI. Rejection under 35 U.S.C. §103(a) to Horwitz

Claims 1-3, 7 and 11 also stand rejected as assertedly obvious over WO 92/01417 by Horwitz (Horwitz). Applicants respectfully traverse the rejection.

Horwitz is directed to a system, apparatus and method for improved measurement of predetermined parameters of an element, such as an eye or a planar or curvilinear surface. *See* Horwitz at pg. 7. Applicants respectfully submit that not only is Applicants' claimed invention not obvious in view of Horwitz, but that Horwitz fails to teach any spectacle lens at all, much less one that corrects for non-conventional refractive error. At most, Horwitz is directed to a wave-front analysis system that measures for certain vision problems.

Applicants respectfully note that the Examiner cites page 8, lines 30-35 and page 33, lines 29-35 in Horwitz as disclosing a spectacle lens. However, in both instances, Horwitz merely states that a vision prescription determined by the disclosed system can be used in the

subsequent production of spectacle lenses: "In a preferred form of the invention, the measurement characteristic is the retinal surface characteristics of the eye and the topography of the epithelial surface and endothelial surface. With this information, refractive and diffractive characteristics of the eye are obtained. This *can permit* for correction by...eyeglasses..."

Horwitz, pg. 8, lines 29-35. However, the production of lenses to correct for non-conventional refractive error, particularly those that can be edged to fit within a spectacle frame, is not trivial; Horwitz contains no teaching or suggestion as to how to produce such lenses or that they could even be produced at all.

Thus, as a *prima facie* case of obviousness has not been presented and the rejection should be withdrawn.

CONCLUSION

For at least these reasons, Applicants respectfully submit that claims 1-12, 59, 71-85, 89-90, and 96-98 are in condition for allowance and the Application should be allowed and passed to issue. In the event any outstanding issues remain, Applicant would appreciate the courtesy of a telephone call to Applicants' undersigned representative to resolve such issues in an expeditious manner.

This Amendment/Response is filed within three months of the mailing date of the Office Action and it is believed that no additional fees are due. In the event Applicants are mistaken in their calculations, the Commissioner is authorized to charge any fees that may be determined to be due to the undersigned's Deposit Account No. 08-3436.

Date: October 13, 2004

Respectfully submitted,



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